

**REMARKS**

Claims 1 to 30 are pending in this application. All of the claims have been rejected. By this amendment, Applicant has canceled claims 1 to 20, and 30 without prejudice; amended claims 21 and 28 for clarity, and added new claims 31 to 34. No new matter has been added, full support for the amendments being found in the specification and drawings as filed.

In view of the above amendments and the following remarks, Applicant respectfully submits that this application is in condition for allowance. Accordingly, reconsideration and a timely Notice of Allowance are respectfully requested.

**The Present Invention**

The present invention is directed to a novel and nonobvious method for managing intellectual property rights in an intellectual property arising from one or more contract documents. The present invention, according to an embodiment, provides an intellectual property rights management method using a computer based interface to pose questions designed to elicit critical information about intellectual property rights, answered by those who have the best understanding of the rights acquired, to allow authorized individuals to determine the scope and extent of their holdings. The method comprises the steps of: packaging at least one contract document and pertinent legal questions pertaining to the intellectual property, directing the review of the at least one contract document and pertinent legal questions, acquiring responses to the pertinent legal questions, and storing the acquired responses in a database to permit searching of the acquired responses.

**Claim Objections**

The Examiner objected to claim 9 as being an improper dependent claim. Applicant has canceled claim 9 and respectfully submits that this objection has been obviated.

**Rejections Under 35 U.S.C. § 112, First Paragraph**

The Examiner rejected claims 1 to 30 under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with the which it is most nearly connected to make and/or use the invention. In particular, the Examiner states that it is unclear from the disclosure how the computer would be programmed, without undue experimentation to convert text and essay questions and responses into computer data in order to take into account all of the subjective answers which the process appears to entail. Additionally, the Examiner states that the specification lacks guidance as to how to use the data in maximizing use of the assets. The Examiner's rejection has been carefully considered, but is respectfully traversed.

As explained in the specification and drawings as filed, for example in paragraphs 81 and 155, the electronic questionnaires can allow answers to be placed on the form, such as by typing in text fields on the form, as well as by selecting from pull-down boxes and radio buttons listing possible answer choices. Additionally, a legal opinion may be attached directly to the questionnaire. The answers are then gathered from the form and placed in a searchable database.

Applicant respectfully submits that one skilled in the art would know how to how program a computer to take the answers and

place them in a searchable database. Applicant notes that the responses are either predetermined values from radio boxes and pull down menus or text entered in specific areas of the questionnaire, all of which can be placed in a searchable database without undue experimentation.

Once the database is populated, the data can be used to maximize use of the assets. As explained in paragraphs 172 to 177 of the specification, searches can be conducted to determine, for example, all of the possible rights associated with different project types, specific intellectual properties, and all properties that have distribution rights in specific foreign territories.

Accordingly, Applicant respectfully requests that this rejection be withdrawn.

**Rejections Under 35 U.S.C. § 112, Second Paragraph**

The Examiner rejected claims 1 to 19 under 35 U.S.C. § 112, second paragraph as being indefinite for the reasons given in section 5 of the Office action. Although Applicant does not agree with the Examiner, Applicant has canceled claims 1 to 19 to advance prosecution of this application and submits that this rejection has been obviated as to these claims.

Additionally, the Examiner rejected claim 27 as being indefinite. Applicant has amended claim 27 for clarity. Applicant has adopted the language "the management program performing the steps of" as suggested by the Examiner. Accordingly, Applicant respectfully submits that claim 27, as amended, meets the requirements of 35 U.S.C. § 112.

Therefore, Applicant respectfully requests that this rejection be withdrawn.

**Rejections Under 35 U.S.C. § 101**

The Examiner rejected claims 1 to 30 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant respectfully traverses this rejection.

The Examiner only specified a detailed rejection with regard to claims 14, 15, 17, 18 and 30. Accordingly, Applicant only addresses the specified rejections herein, but will gladly address this rejection with regard to specific rejections of any additional claims in the future.

Although the Applicant does not agree with the Examiner's position, Applicant has canceled claims 1 to 20, and 30 to advance prosecution of this application. In view of the cancellation of claims 1 to 20, and 30, Applicant respectfully submits that this rejection has been obviated. Additionally, Applicant submits that the claimed invention as a whole does not encompass a human being. Human beings utilize the systems and methods of the present invention, but this does not run afoul of 35 U.S.C. §101. Indeed both references cited by the Examiner are similar; see col. 4, lines 26 to 30 of U.S. Patent No. 6,330,547 to Martin; and paragraphs 0301, 0302 and table 1 of U.S. Patent Publication No. US2003/0046307 A1 to Rivette et al.

Additionally, the Examiner states that claims 1 to 30 do not produce a "concrete" result. Applicant respectfully disagrees. As explained in MPEP §2106, the expansive language of 35 U.S.C. §101 includes "anything under the sun that is made by man." Patents may be obtained on any new and useful machine, manufacture, composition of matter or a process. Claims 21 to 29 are directed to a new and useful process. The present invention

is not drawn to non-statutory descriptive material such as abstract ideas, laws of nature or natural phenomena.

The present invention leads to the creation of a searchable database of interrelated intellectual property rights. Insufficient attention to rights management may result in the loss of millions of dollars or revenue opportunities and the loss of the intellectual property itself. The methods of the present invention enhance the ability of a person or business to exploit and protect its intellectual property assets. Therefore, Applicant respectfully submits that the claimed methods fall under the broad umbrella of 35 U.S.C. §101.

Accordingly, Applicant respectfully requests that this rejection be withdrawn.

**Rejections Under 35 U.S.C. § 102**

The Examiner rejected claims 1 to 22, 26 and 27 under 35 U.S.C. § 102 as being anticipated by Rivette et al. (U.S. Patent Publication No. US 2003/0046307). Claims 1 to 20 have been canceled, but Applicant respectfully traverses this rejection as to the remaining claims.

Independent claim 21 recites "packaging the one or more than one contract document and pertinent legal questions comprising one or more than one legal question pertaining to the intellectual property" and "directing the review of the one or more than one contract document and the one or more pertinent legal questions." Independent claim 27 recites "packaging the one or more than one contract document and the legal questions." Applicant respectfully submits that Rivette et al. fail to teach or suggest these limitations.

Rivette et al. are directed to a system, method, and computer program product for processing data relating to patents. With regard to claim 21 the Examiner states that Rivette et al. teach packaging the packaging step in Figure 102(10210) and the directing step in Figure 102 (10210), and Figure 104. Applicant respectfully submits that the portions of Rivette et al. cited by the Examiner fail to teach or suggest the limitations of claim 21 listed above. As explained in paragraphs 1083 to 1091, an operator can determine which patents are involved in a bill of materials. After obtaining the list of patents, the user can consider many different types of business questions. Although, Rivette et al. discuss different types of questions that may be considered by an operator, Rivette et al. does not discuss the packaging of one or more pertinent legal questions with a contract document. Additionally, Rivette et al. does not direct the review, but rather allows an operator to see which patents relate to a bill of materials. Accordingly, Applicant respectfully submits that Rivette et al. fail to teach all of the limitations of independent claims 21 and 27.

Claims 22 and 26 depend from claim 21 and by definition contain all of the limitations of claim 21. Accordingly, Applicant respectfully submits that claims 22 and 26 are patentable over Rivette et al. for the reasons given above with regard to claim 21 as well as because of the additional limitations contained therein.

With regard to claim 22, the Examiner states that the limitation "routing the one or more than one contract document, the pertinent legal questions and the data records to the review module." Is taught in Figure 101 of Rivette et al. Applicant has amended claim 22 to change "the review module" to "a reviewer"

for clarity. There is no antecedent basis for "the review module." Applicant respectfully submits that Rivette et al. does not teach routing "the one or more than one contract document, the pertinent legal questions, and the data records to a reviewer."

With regard to claim 26, the Examiner does not specify where the limitations of this claim are taught in Rivette et al. Applicant respectfully submits that Rivette et al. fails to teach or suggest "sending the one or more than one contract document to a legal source for review."

Accordingly, Applicant respectfully requests that this rejection be withdrawn.

**Rejections Under 35 U.S.C. § 103**

The Examiner rejected claims 23 to 25 and 28 to 30 under 35 U.S.C. § 103 as being unpatentable over Rivette et al. (U.S. Patent Publication No. US 2003/0046307) in view of Martin (U.S. Patent No. 6,330,547). Applicant has canceled claim 30, but respectfully traverses this rejection with regard to the remaining claims.

The Examiner states that Rivette et al. fail to teach or suggest questionnaires, as recited in claims 23 to 25 and 28 and cites to Martin to remedy the defects of Rivette et al. However, Applicant respectfully submits that Martin fails to remedy the defects of Rivette et al.

Martin is directed to a method and apparatus for deciding whether to make a loan using an intangible asset, such as intellectual property. The method requires that an assessment of the transferability and viability of the asset be made to determine if the asset and loan applicant meet minimum qualifying

criteria. Although Martin discloses that data, including answers to questionnaires prepared by the user in advance may be entered into a computer, the data relates to the identity and financial and legal status of the applicant, not the intellectual property as claimed.

Thus, neither Rivette et al. nor Martin, taken alone or in combination teach or suggest "offering choice of rights questionnaires, receiving a request for one or more than one rights questionnaire, and generating the one or more than one rights questionnaire requested" as recited in claim 23. Further neither Rivette et al. nor Martin, taken alone or in combination teach or suggest "automatically generating one or more than one rights questionnaire based upon the information in the data records" as recited in claim 24. Finally, neither Rivette et al. nor Martin, taken alone or in combination teach or suggest "preparing one or more than one rights questionnaire having one or more than one question designed to elicit critical information about ownership rights in intellectual property" as recited in claim 25.

With regard to claim 28 neither Rivette et al. nor Martin, taken alone or in combination teach or suggest "preparing a package having one or more than one rights questionnaire and the one or more than one contract document" or "routing the package for review, the rights questionnaire having one or more than one question" as recited. Claim 29 depends from claim 28 and by definition contains all of the limitations of claim 28. Therefore, Applicant respectfully submits that claim 29 is patentable over Rivette et al. and Martin for the reasons given above regarding claim 28 as well as because of the additional limitations contained therein.



Additionally, Applicant respectfully submits that one skilled in the art would have no motivation to combine the features of Martin and Rivette et al. The Examiner states that it would have been obvious to one of ordinary skill in the art incorporate into the patent information management method of Rivette et al., the questionnaires taught in Martin so as to guide the user to provide the complete data necessary to perform an analysis. However, the questionnaires taught in Martin only relate to the identity and financial and legal status of a loan applicant. Applicant respectfully submits that the identity and financial and legal status of a loan applicant is irrelevant to the system and method of Rivette et al. which is unconcerned with loan applications. Therefore, one skilled in the art would have no motivation to combine Martin and Rivette et al.

Therefore, Applicant respectfully requests that his rejection be withdrawn.

#### **New Claims**

New claims 31 to 34 have been added to more completely claim aspects of the present invention. New claims 31 and 32 find full support in the specification and drawings as filed, for example, in paragraphs 137 to 141. New claims 33 and 34 find full support in the specification and drawing as filed, for example, in paragraphs 81 and 155. No new matter has been added. Entry of new claims 31 to 34 is respectfully requested.

Applicant submits that new claims 31 to 34 are patentable over the art cited by the Examiner. Claim 31 depends from claim 21, claims 32 and 33 depend from claim 26, and claim 34 depends from claim 28, and by definition contain all of the limitations of claims 21, 26, and 28 respectively. Therefore, Applicant

respectfully submits that claims 31 to 34 are patentable over Martin and Rivette et al for the reasons given above with regard to claims 21, 26, and 28 above. Additionally, Applicant respectfully submits that neither Martin nor Rivette et al, considered alone or in combination, teach or suggest sending and receiving responses to legal questions via e-mail as recited in claim 32. Moreover, Applicant respectfully submits that neither Martin nor Rivette et al. teach or suggest prompting selection of one or more special format answers as recited in claims 31 and 34.

Accordingly, Applicant respectfully submits that new claims 31 and 34 are in condition for allowance.

#### **CONCLUSION**

In view of the above amendments and remarks, Applicant respectfully submits that this application is in condition for allowance. Therefore, reconsideration and a timely indication of allowance are respectfully requested. If the Examiner believes a telephone conference would aid in the prosecution of this application, then the Examiner is invited to contact the undersigned, or Marc Karish (Reg. No. 44,816) at the below listed telephone number.

A fee of \$1,020 is believed due for a three month extension of time. The Commissioner is hereby authorized to charge payment of

this fee and other fees associated with this communication to  
Deposit Account No. 19-2090.

Respectfully submitted  
SHELDON & MAK PC

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